

REMARKS

Applicant has carefully considered the Final Office Action of December 2, 2004 and the Advisory Action of February 22, 2005, and offers the following remarks to accompany the above amendments and concurrently filed Request for Continued Examination. As the four month date was April 2, 2005, Applicant also has requested a two month extension of time. The enclosed Credit Card Payment Form pays for the RCE and the extension of time.

Applicant herein amends independent claims 1, 32, 33, and 40 to clarify the nature of the utilization of the trunk. In particular, the claims are amended to recite "wherein said utilization of said trunk corresponds to a congestion level of said trunk. . . ." Support for this amendment can be found on page 2, lines 5-20 of the application as filed. No new matter is added.

Claims 1-3, 7-10, 32-37, and 40-42 were rejected under 35 U.S.C. § 103 as being unpatentable over Gavrilovich. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is shown in the prior art. MPEP § 2143.03. If the Patent Office relies on a single modified reference, the Patent Office must first articulate a motivation to modify the reference, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

As amended, claims 1, 32, 33, and 40 recite the nature of the utilization as being a measure of the congestion of the trunk. Gravilovich does not teach or suggest this element. Specifically, Gravilovich teaches the detection of defective trunks based on the number of unacknowledged communications in a group of trunks. The Patent Office has indicted that the detection of these unacknowledged communications is a form of detection of a type of utilization of the trunk. However, as Applicant has previously argued, and is now made explicit within the independent claims, Applicant's indication of an utilization is related to the congestion of the trunk and not to a number of unacknowledged communications, as taught by Gravilovich.

The Patent Office has not articulated any motivation to modify Gravilovich's measure of under-utilized trunks to a measure of congestion. Since this element is not shown or suggested by Gravilovich, the Patent Office has not established obviousness for the independent claims. Since the Patent Office has not established obviousness for the independent claims, independent claims 1, 32, 33, and 40 are allowable. Since independent claims 1, 32, 33, and 40 are allowable, dependent claims 2, 3, 7-10, 34-37, 41, and 42 are allowable.

Claims 1, 32, 33, and 40 were rejected under 35 U.S.C. § 103 as being unpatentable over Ash et al. (hereinafter "Ash"). Applicant respectfully traverses. The standard for patentability is set forth above.

As noted above, to modify a single reference, the Patent Office must articulate a motivation to modify the reference and support the motivation with actual evidence. The Patent Office opines that the motivation to monitor the utilization of each trunk in the group of trunks is "to obtain the measurement." This asserted motivation lacks any evidence in support thereof. To this extent, the asserted motivation is improper. Since the asserted motivation is improper, the modification is improper. The Patent Office admits that Ash without modification does not show all the elements. Thus, since it is improper to modify Ash, and Ash without modification does not show all the elements, Ash does not establish obviousness for claims 1, 32, 33, and 40. Claims 1, 32, 33, and 40 are allowable for this reason as well.

Claims 4-6, 14-29, and 39 were rejected under 35 U.S.C. § 103 as being unpatentable over Gavrilovich in view of Ash. Applicant respectfully traverses. The standard for establishing obviousness is set forth above. Furthermore, for the Patent Office to establish obviousness over a combination of references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the two references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

The Patent Office asserts that the motivation to combine Gavrilovich and Ash is "to have specific characteristics relate to the new connections to assist routing purposes." This asserted motivation lacks the requisite actual evidence in support thereof. Since the motivation lacks the requisite evidentiary support, the motivation to combine Gavrilovich and Ash is improper. Since the motivation to combine the references is improper, the combination is improper. Since the combination is improper, and the references individually admittedly do not teach or suggest all the elements, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claims 4-6, 14-19 and 39 are allowable.

Applicant further traverses the combination of Gavrilovich and Ash as creating a non-functional combination that renders one or the other reference unsuitable for its intended purpose, which is further evidence of non-obviousness. MPEP § 2143.01. Gavrilovich is concerned with detecting defective communication circuits as evidenced by unacknowledged

communications. Unacknowledged communications equate to a communication path that is not loaded heavily. That is, since the communications are unacknowledged, the circuits are still available for additional communication attempts. In contrast, Ash is directed to the least loaded path for each connection. Thus, if the references are combined, Gravitovich tries to determine that a communication path is defective because the trunk has a high number of unacknowledged communications (and thus is not heavily loaded), while Ash's system tries to route communication attempts onto the defective communication path because it is the least loaded path. These two criteria are at odds with one another and make the combined system unsatisfactory for one of the references intended purpose. This unsatisfactory evolution of one reference is further evidence of non-obviousness.

Claims 11-13, 30, 31, 38, and 43-46 were rejected under 35 U.S.C. § 103 as being unpatentable over Gavrilovich in view of Ackerley et al. (hereinafter "Ackerley"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

Applicant initially traverses the rejection because the Patent Office has not provided a proper motivation to combine the references. In particular, the Patent Office opines that the motivation to combine the references is "to inform the source and alert the database before generating new routing sequences." However, this asserted motivation is not supported with the requisite actual evidence. Since the asserted motivation is not properly supported, the motivation is improper. Since the motivation is improper, the combination is improper. As admitted by the Patent Office, the references individually do not establish obviousness. Since the references individually do not establish obviousness, and the combination is improper, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claims 11-13, 30, 31, 38 and 43-46 are allowable.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The references of record do not teach the claimed invention and are not properly combinable. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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